

REMARKS

Applicant has carefully studied the Final Office Action of June 3, 2005 and offers the following remarks to accompany the above amendments. Applicant appreciates the telephonic interview with Examiners Klimach and Smithers on July 14, 2005.

During the telephonic interview, Applicant discussed the differences between the invention and Paul. Specifically, the present invention is designed to allow a user to customize a computing session on a host computer through the use of a portable device. The portable device has memory and software stored thereon. When the portable device interfaces with the host computer, the software on the portable device automatically executes and customizes the computing session that the user then undertakes on the host computer. The launch and customization of the computing session takes place without requiring the host computer to go through a boot sequence.

In contrast, as explained during the telephonic interview, Paul teaches a set of software that customizes a user interface by controlling the boot sequence of the host computer. If the host computer is already operational and Paul's device is coupled thereto, the host computer has to go through another boot sequence to secure the customization of Paul's device.

The Interview Summary mailed July 19, 2005 summarizes the distinction as the "difference being the memory device changes the configuration of the computing session (assuming the computing session is an application) rather than changing the configuration of the boot as performed by the reference."

Applicant herein amends the independent claims 1, 14, 19, and 27 to recite that the software on the portable device automatically executes and configures other software running on the host computing device without requiring the host computer to boot. Support for this amendment can be found at page 14, line 32-page 15, line 5. No new matter is added.

Claims 1-11 and 13-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Paul. Applicant respectfully traverses. For the Patent Office to prove anticipation, the Patent Office must show where each and every element of the claim is located. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

As amended, independent claims 1, 14, 19, and 27 recite that the software on the device configures other software running on the host computing device without requiring the host computer to boot. As discussed during the telephonic interview, Paul does not teach this element

because Paul requires that the host computer go through a boot process to customize the software on the host computer.

In view of the fact that Paul teaches the configuration of the boot of the host computer and the claims recite configuration without requiring the host computer to boot, Paul does not anticipate the claims. Applicant requests withdrawal of the § 102 rejection of claims 1-11 and 13-32 at this time.

During the telephonic interview, the Examiners did indicate that the configuration of the software and not the configuration of the booting of the host computer was a discernable difference. This indication is confirmed in the Interview Summary mailed July 19, 2005. Applicant has amended the claims to present this subject matter to the Patent Office. While the Examiners and Applicant were unable to agree as to whether amended claims along these lines would be patentable, the Examiners did indicate that an amendment along these lines would be a new issue and would require a further search. Rather than file the current response strictly as a response after final, Applicant files the current response in conjunction with a Request for Continued Examination so that the Patent Office is free to explore the issue fully and provide a full, non-final Office Action explaining the Patent Office's position.

Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Scan Tech News Article (hereinafter "Scan Tech"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claims is taught or suggested in the combination of references. MPEP § 2143.03.

As explained above, Paul does not teach that the configuration of the other software without requiring the computer to boot. Nothing in Scan Tech cures this deficiency. Thus, since the references individually do not teach or suggest the claim element, the combination of references does not teach or suggest the claim element. Since the combination of references does not teach or suggest the claim element, the combination does not establish *prima facie* obviousness. Since the combination does not establish obviousness, claim 12 is allowable. Applicant requests withdrawal of the § 103 rejection of claim 12 at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references of record do not teach or suggest that the other

software is configured without requiring the host computer to boot. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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